

REMARKS

Entry of the foregoing Amendment is respectfully requested. The Amendment is believed to place the application in condition for allowance and, therefore, is respectfully submitted to be appropriate under Rule 116. It is submitted that the Amendment does not raise any new issues and, thus, does not require any additional search by the Examiner. The issues presented by the amended claim 1 are the same issues presented by the currently pending claims 1 and 2, with some changes being strictly editorial in nature, which were made to overcome the Examiner's indefinite rejection.

By the present amendment, claim 1 has been amended to include the features of dependent claim 2 to more clearly define the present invention and to eliminate an alleged indefiniteness therein. Claim 2 has been canceled, and claims 4-9 continue unamended

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

II. Objections

In the Office Action, claim 1 was objected to for reciting an incorrect reference number for the support regions. In response, the support region has been changed from "support regions (36, 40, 66)" to "support regions (35, 40, 66)." Withdrawal of the objection is respectfully requested.

II. Rejection Under 35 U.S.C. § 112

The Examiner rejected claims 1, 2 and 4-9 under 35 U.S.C. § 112, second paragraph, as being indefinite, pointing out specific recitations in claim 1 rendering claim 1 and claims 2 and 4-9, dependent thereon, indefinite. Specifically, the Examiner questions how the housing can have the same release direction as the support regions of the adjusting device, as the housing appears to be comprised of multiple parts assembled in multiple directions from multiple locations.

In response, claim 1 has been amended to recite that “all of the support regions of the adjusting device (30) on the housing (4) ~~and the housing (4)~~ have a common release direction (E).”

Generally, the support regions are discussed in the specification (the paragraph, bridging pages 11-12). The release direction (E) is the direction, as pointed in the specification, in which the adjusting device is removed from the housing (4), i.e., all of the support regions face in the same direction.

As such, it is submitted that claim 1, as amended is not indefinite and fully satisfies the requirements under 35 U.S.C. § 112 and is patentable thereunder. Furthermore, claims 2 and 4-9 depend either directly or indirectly from independent claim 1 and recite additional features considered inventive. At least for the same reasons described above, it is submitted that these dependent claims are not indefinite and fully satisfy the requirements under 35 U.S.C. § 112 and are patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

II. Rejection Over the Prior Art

A. Claims 1, 2 and 4-6

The Examiner rejected Claims 1, 2 and 4-6 under 35 U.S.C. §103(a) as being unpatentable over Gerritsen, U.S. Patent No. 5,421,091 (Gerritsen) in view of Morehouse, U.S. Patent No. 1,753,441 (Morehouse) and in further view of U.S. Patent No. 998,318 (Young). Claims 7-8 were rejected respectively under 35 U.S.C. §103(a) as being unpatentable as claims 1-6 above and further in view of Osada, U.S. Patent No. 6,523,267 (Osada) and Smolinski, U.S. Patent No. 5,992,540 (Smolinski). Claim 9 was rejected as claims 1-6 above and further in view of Stowell, U.S. Patent No. RE 37,190 (Stowell). It is respectfully submitted that the pending claims are patentable over the cited references.

Specifically, claim 1 recites:

A motor-driven saber saw (2), comprising a housing (4) having a neck (8) that serves as a handle and has a tool opening (6); guide means (22) for guiding the saber saw (2) on a workpiece and releasably connectable to the housing (4) in a region of the neck (8), the guide means (22) including connection means (21) for connecting the guide means (22) to the housing (4), the neck (8) of said housing (4) having connecting means (16) for guiding the connection means (21); an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing; and a rectilinear spring member (36) for biasing the adjusting device (30) to a locking position thereof and extending substantially parallel to a longitudinal direction of the housing neck (8), said spring member (36) being formed as a springy bar, wherein the neck region (8) of the housing (4) has support regions (35, 40, 66) for the adjusting device (30) and is formed by a die casting process, and all of the support regions of the adjusting device (30) on the housing (4) have a common release direction (E), whereby formation of at least a section of the housing

(4), on which the adjusting device (30) is supported, by the die casting process is insured. (Emphasis added).

As a preliminary matter, we believe that it would be helpful to review the appropriate standard under 35 U.S.C. § 103 for analyzing the features of a claim with respect to the prior art. It is well settled that [t]he test under 35 U.S.C. § 103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

The combination of the cited patents fails to disclose or suggest that “all of the support regions of the adjusting device (30) on the housing (4) have a common release direction (E).” In particular, the release direction (E) is the direction in which the adjusting device is removed from the housing (4), i.e., all of the support regions face in the same direction. Generally, the support regions are discussed in the specification (the paragraph, bridging pages 11-12).

By contrast, the combination of the Gerritsen, Morehouse and Young patents teaches away from the present invention. In particular, the cited patents disclose a first release direction formed by the shell section 12 and the slot 20, and a second release direction formed by shell 14 in the Gerritsen patent.

Even if the Morehouse and Young patents could somehow be operably combined, the combination of the cited art fails to disclose or suggest that “all of the support regions of the adjusting device (30) on the housing (4) have a common

release direction (E).” Advantageously, this allows the region where the adjusting device is supported to be formed by a die casting process, which eliminates the need for additional machining during fabrication and thereby, reduced manufacturing costs. Additionally, the single release direction simplifies the assembly of the saber saw (see specification, page 5, lines 5-11).

Furthermore, nowhere in the combined cited patents is there any disclosure or suggestion regarding “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing.” The present invention provides a rectilinear spring member for biasing the locking member to its locking position and which extends substantially in a longitudinal direction of the housing neck. With such a spring member, a very flat mounting space is required for the adjusting device (30) that flatly abuts the housing in the region of the housing neck (8). Advantageously, a slim housing neck can be utilized in the saber saw which permits good handle ergonomics. (see specification, page 4, line 14 to page 5, line 2). By contrast, the cited patents teach away from the present invention, since the plunger 45 of Gerritsen is located at the lower end of the housing of the saber saw, as opposed to the neck/handle of the saber saw.

Accordingly, the present invention provides an adjustment device that is conveniently positioned in the neck of the housing, which serves as a forward handle of the saber saw. Positioning the adjustment device in the neck also facilitates ease of use during operation of the saber saw over the cited prior art, since the user does not have to place his or her hand at the lower end of the saber saw to adjust the guide and risk injury from the blade, especially if the blade is in a

retracted position relative to the saber saw housing. Thus, the present invention reduces the risk of injury to user when adjusting the positioning of the guide.

As such, it is submitted that claim 1, as amended, is not obvious and fully satisfies the requirements under 35 U.S.C. § 103 and is patentable thereunder. Furthermore, claims 2 and 4-6 depend either directly or indirectly from independent claim 1 and recite additional features considered inventive. At least for the same reasons described above, it is submitted that these dependent claims are not obvious and fully satisfy the requirements under 35 U.S.C. § 103 and are patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

B. Claims 7 and 8

Claims 7 and 8 depend indirectly from independent claim 1 and recite additional features considered inventive. The combination of the cited prior art fails to disclose or suggest that “all of the support regions of the adjusting device (30) on the housing (4) have a common release direction (E)” and “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing.”

As discussed above, the combination of the Gerritsen, Morehouse and Young patents teaches away from the present invention, since multiple release directions are disclosed, and the adjusting device is positioned on the lower end of the housing of the saber saw, as opposed to being advantageously positioned on the neck/handle of the saber saw.

Furthermore, the Osada and Smolinsky patents fail to bridge the substantial gap as between the Gerritsen, Morehouse and Young patents and the present invention. Osada discloses “A front cover, made of an electrically and thermally insulating material, covers an outer surface of the housing. And, a resilient member, which is also electrically and thermally insulating, extends along an outer surface of the front cover partly so as to form a front-end grip to be held by a user.” (See Osada, col. 1, line 38-43 and FIG. 5).

Moreover, Smolinski discloses:

The grip jacket 40 and the housing 11 are arranged so that, in use, the palm of a user's hand rests on the top of the jacket 40, while his fingers wrap beneath the handle portion 42 of the jacket 40 just forwardly of the tab projection 44. ... Preferably, there is also provided a trigger cover 57 formed of a suitable flexible and resilient material, such as a suitable plastic, which covers the trigger pad 56 and has a peripheral lip 58, which engages the inner surface of the jacket handle portion 42 around the periphery of the opening 54, as can best be seen in FIGS. 6 and 8. (See Smolinski, col. 4, lines 23-37).

Even if the five cited patents could operably be combined, nowhere in the combination is there any disclosure or suggestion of “all of the support regions of the adjusting device (30) on the housing (4) have a common release direction (E)” and “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing.” Therefore, the combination of the cited patents fails to teach or suggest the present invention as a whole.

As such, it is submitted that claims 7 and 8 are not obvious and fully satisfy the requirements under 35 U.S.C. § 103 and are patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

C. Claim 9

Claim 9 depends indirectly from independent claim 1 and recites additional features considered inventive. The combination of the cited prior art fails to disclose or suggest that “all of the support regions of the adjusting device (30) on the housing (4) have a common release direction (E)” and “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing.”

As discussed above, the combination of the Gerritsen, Morehouse, Young, Osada and Smolinsky patents teaches away from the present invention, since multiple release directions are disclosed, and the adjusting device is positioned on the lower end of the saber saw, as opposed to being advantageously positioned on the neck/handle of the saber saw.

Furthermore, the Stowell patent fails to bridge the substantial gap as between the Gerritsen, Morehouse, Young, Osada and Smolinsky patents and the present invention. The Stowell patent discloses:

Anchored in each concave depression is an array of equi-spaced fins 19. Because the handle is formed of elastomeric material, fins 19 are highly flexible. The array of fins forms a grip site whereby when the fins are pressed in by the forefinger and thumb of a user's hand, this action enhances the user's grip on the handle. (See Stowell, col. 3, line 66 to col. 4, line 4).

Even if the six cited patents could operably be combined, nowhere in the combination is there any disclosure or suggestion of “all of the support regions of the adjusting device (30) on the housing (4) have a common release direction (E)” and “an adjusting device (30) mountable on the connecting means (16) of said neck (8) for securing the connection means (21) to the housing.” Therefore, the combination of the cited patents fails to teach or suggest the present invention as a whole.

As such, it is submitted that claim 9 is not obvious and fully satisfies the requirements under 35 U.S.C. § 103 and is patentable thereunder. Therefore, withdrawal of the rejection is respectfully requested.

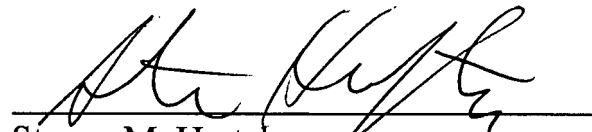
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned at (212) 885-9223.

The Commissioner is hereby authorized to charge any additional fees, or to credit any overpayment, due by reason of this Amendment to Deposit Account No. 01-0035.

Respectfully submitted,


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